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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 10/708,969 | 04/04/2004 | Robert Clarence LaLonde | | 2968 |

39827 7590 03/07/2007
ROBERT C. LALONDE
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AUGUSTA, GA 30909

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| EXAMINER |
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DEBNATH, SUMAN

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| ART UNIT | PAPER NUMBER |
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2135

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/07/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/708,969

Applicant(s)

LALONDE ET AL.

Examiner

Suman Debnath

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-3 are pending in this application.

Oath/Declaration

2. A new oath or declaration is required because it was not executed in accordance with 37 CFR 1.66. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 are rejected as it fails to define the invention in a manner required by 35 U.S.C. 112, second paragraph. The claims are abstract in form and replete with indefinite and functional or operational language. **The steps, which go to make up the method, must be clearly and positively specified.** No steps were cited for claims 1-3 which would clearly and positively specify the steps of claimed invention.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 could reasonably be drawn to functional descriptive material, per se, i.e., "secure e-mail forwarding" may be taken to mean software alone, and as such, claim 1, would be directed to non-statutory subject matter.

Claim 2 is rejected under 35 U.S.C. 101 because the claim is directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which sets forth the statutory classes of invention in the alternative only. *Ex parte Lyell*, 17 USPQ2d 1551 (Bd. Pat. App. & Inter. 1990).

Claim 3 could reasonably be drawn to functional descriptive material, per se, i.e., "encrypted marketing" may be taken to mean software alone, and as such, claim 3, would be directed to non-statutory subject matter.

Further, claims 1 and 3 do not necessarily transform a physical object to a different state or thing nor produce a useful, concrete and tangible results.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Nemovicher (Pub. No.: US 2002/0007453 A1).

9. As to claim 1, Nemovicher discloses method for providing consumer anonymity via secure e-mail forwarding (FIG. 1, [0039]).

10. As to claim 2, Nemovicher discloses specific email server, web applications, and client plug-ins to be developed to support anonymous consumers (FIG. 12, [0093]).

11. As to claim 3, Nemovicher discloses method for support of confidential encrypted marketing ([0121], [0021]).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See accompanying PTO 892.

Scott (Pub. No.: US 2005/0102511 A1) discloses an email system which uses limited life key to send email in order to prevent spamming.

B. Ramsdell ("RFC 2633: S/MIME Version 3 Message Specification", Network Working Group, June 1999) discloses cryptographic security services to mail.

Assmann (Patent Number: US 6,986,037 B1) discloses an electronic mail system with encryption methodology for allowing connections to/from a message forwarding agent.

Olkin et al. (Pub. No.: US 2003/0046533 A1) discloses a security server to transmit email.

Liu et al. (Patent No.: US 6,760,752 B1) discloses a method of encrypting an email message before transmitting.

Appenzeller et al. (Patent No.: US 6,886,096 B2) discloses a method for retrieving a public key before sending an encrypted message to a recipient.

Walker et al. (Pub. No.: US 2002/0023213 A1) discloses an encryption system that dynamically locates keys.

McArdle et al. (Patent No.: US 6,442,686 B1) discloses a secure email system, which uses digital signature for authentication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suman Debnath whose telephone number is 571 270 1256. The examiner can normally be reached on 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100